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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/575,776 | 05/22/2000 | Cheryl Henry | H546.12-0001 | 2785 |

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EXAMINER

VORTMAN, ANATOLY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2835

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,776

Applicant(s)

HENRY, CHERYL

Examiner

Anatoly Vortman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 January 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Amendments

1. Submission of the amendment filed on 01/17/02 is acknowledged. At this point claims 1, 2, 4-6, and 10-12 are amended and new claims 13-22 are added. Thus, claims 1-22 are pending in the instant application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-16, and 18-22, are rejected under 35 U.S.C. 102(b) as being anticipated by US/5,566,290 to Silverbrook.

Regarding claims 1 and 6, Silverbrook disclosed (Fig. 1 and 2) a portable apparatus (1) for reading only file directory information stored on a separately portable self contained data storage device (11), the portable apparatus not in communication with a personal computer, the apparatus comprising:

a handheld housing (2, 9) (the housing may be held in hands if so desired);

a drive component (79) for reading the file directory information on the data storage device (11), (column 2, lines 4+);

a loading mechanism (79) for receiving the data storage device (11) and retaining the data storage device such that the drive component (79) reads the file directory information on command (column 2, lines 4+); and

a visual display (4) operably connected to the drive component for viewing the file information contained on the data storage device (11).

Regarding claims 6 and 16, Silverbrook further disclosed a printer (an output device) operably connected to the drive component to print the file directory contents contained on the display (4), (column 3, lines 45+).

Regarding claims 13 and 14, Silverbrook disclosed at least one data storage drive (79 or 78) for reading the file directory information from at least one respective type of data storage device (11 or 21); and a visual display output device (4) for providing the file directory information contained on the data storage device (11 or 21).

Regarding claim 2, Silverbrook disclosed a printer (column 3, lines 45+) to print the file directory information retrieved from the data storage device (11) by the drive component (79).

Regarding claims 3 and 15, Silverbrook disclosed that the visual display (4) is a liquid crystal display (column 1, line 66).

Regarding claims 4 and 19, Silverbrook disclosed that the drive component reads magnetic storage media (21), (column 2, lines 26+).

Regarding claims 5 and 20, Silverbrook disclosed that the drive component reads optical storage media (column 2, lines 4+).

Regarding claims 8 and 18, Silverbrook disclosed that the printer is an attachable unit (column 3, lines 45+).

Regarding claims 10-12, the method steps recited in the claims are inherently necessitated by the device structure as disclosed by Silverbrook.

Regarding claims 9, 21 and 22, Silverbrook disclosed two drive (a plurality) components (78 and 79) on of which is a magnetic storage drive (78) and another is an optical storage drive (79).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7 and 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook.

Regarding claims 7 and 17, Silverbrook disclosed all of the claim's limitations as apply to claims 6 and 16 respectively, but did not disclose that the printer is located within the housing of the apparatus. The official notice is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate said printer within the apparatus housing in order to enhance the versatility of the device, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Response to Arguments

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6. Applicant's arguments filed on 01/17/02 have been fully considered but they are not persuasive.

The main thrust of Applicant's arguments is directed to the fact that apparatus of the present invention is designed to read only the file directory and not any other type of data, as capable the device of Silverbrook.

The Examiner would like to direct the Applicant's attention to the fact that the device of Silverbrook would also read only the file directory if such will be only contained on the media storage device.

Also, please note that the file directory is not a structural limitation, but only a type of the data (i.e. an information), which is irrelevant to the structure of the device, and the recitation that claimed device is capable of reading such data, is a functional recitation, which does not have a patentable weight, because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function (i.e. the reading of only the file directory information), as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claim 9, the Applicant has stated in the remarks that claim has been cancelled (p. 7 of the Amendment, line 6), but at the same time the claim is listed as currently pending in the body of the amendment (p. 4). Thus, the claim has been treated as pending.

Conclusion

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7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824. The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

A.V.
February 25, 2002

A handwritten signature in black ink, appearing to read 'A. Vortman', followed by a horizontal line.

Anatoly Vortman
Examiner
Art Unit 2835